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# UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/965,553	09/27/2001	David A. Wright	900.175US2	5748

26191 7590 03/25/2003

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MINNEAPOLIS, MN 55402

EXAMINER

MEHTA, ASHWIN D

ART UNIT	PAPER NUMBER
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1638

DATE MAILED: 03/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/965,553

Applicant(s)

WRIGHT ET AL.

Examiner

Ashwin Mehta

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 September 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 49-109 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 49-109 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

***Status of the Application***

1. Claims 73-132, submitted in the preliminary amendment, have been renumbered 49-109, respectively, in accordance with 37 CFR. 1.126, as the application contained original claims 1-49 (which were cancelled in the same preliminary amendment).

***Election/Restrictions***

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 49-59, 77, 78, 109, drawn to an isolated nucleic acid that encodes a plant retroviral primer binding site and also comprises SEQ ID NO: 4; a vector that can transfer said nucleic acid to a plant cell; a seed or plant comprising said nucleic acid; said nucleic acid further encoding an agronomically-significant characteristic; a method to impart agronomically significant characteristics to a plant, classified in class 800, subclass 278, for example.
  - II. Claims 49-56, 60-64, 77, 78, 109, drawn to an isolated nucleic acid that encodes a plant retroviral primer binding site and also encodes at least a portion of a plant envelope sequence comprising SEQ ID NO: 5; a vector that can transfer said nucleic acid to a plant cell; a seed or plant comprising said nucleic acid; said nucleic acid further encoding an agronomically-significant characteristic; a method to impart agronomically significant characteristics to a plant, classified in class 435, subclass 419, for example.
  - III. Claims 49-56, 60, 65-68, 77, 78, 109, drawn to an isolated nucleic acid that encodes a plant retroviral primer binding site and also comprises at least a portion

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of a plant integrase sequence comprising SEQ ID NO: 9; a vector that can transfer said nucleic acid to a plant cell; a seed or plant comprising said nucleic acid; said nucleic acid further encoding an agronomically-significant characteristic; a method to impart agronomically significant characteristics to a plant, classified in class 435, subclass 468, for example.

- IV. Claims 49-56, 60, 69-72, 77, 78, 109, drawn to an isolated nucleic acid that encodes a plant retroviral primer binding site and also comprises at least a portion of a plant reverse transcriptase sequence comprising SEQ ID NO: 11; a vector that can transfer said nucleic acid to a plant cell; a seed or plant comprising said nucleic acid; said nucleic acid further encoding an agronomically-significant characteristic; a method to impart agronomically significant characteristics to a plant, classified in class 536, subclass 23.6, for example.
- V. Claims 49-56, 60, 73-76, 77, 78, 109, drawn to an isolated nucleic acid that encodes a plant retroviral primer binding site and also comprises at least a portion of a plant RNaseH sequence comprising SEQ ID NO: 15; a vector that can transfer said nucleic acid to a plant cell; a seed or plant comprising said nucleic acid; said nucleic acid further encoding an agronomically-significant characteristic; a method to impart agronomically significant characteristics to a plant, classified in class 435, subclass 410, for example.
- VI. Claims 79-89, 107, 109, drawn to an isolated nucleic acid that encodes a plant retroviral polypurine tract and comprises SEQ ID NO: 4; a method to transfer said nucleic acid into a plant cell, classified in class 536, subclass 23.72, for example.

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- VII. Claims 79-85, 90-93, 107, 109, drawn to an isolated nucleic acid that encodes a plant retroviral polypurine tract and further comprising at least a portion of a plant envelope sequence, and further encoding at least one agronomically-significant characteristic; a vector that can transfer said nucleic acid to a plant cell; a seed or plant comprising said nucleic acid; a method to impart agronomically significant characteristics to a plant, classified in class 435, subclass 320.1, for example.
- VIII. Claims 79-85, 94-97, 107-109, drawn to an isolated nucleic acid that encodes a plant retroviral polypurine tract and further comprising at least a portion of a plant integrase sequence, and further encoding at least one agronomically-significant characteristic; a vector that can transfer said nucleic acid to a plant cell; a seed or plant comprising said nucleic acid; a method to impart agronomically significant characteristics to a plant, classified in class 800, subclass 282, for example.
- IX. Claims 79-85, 98-101, 107, 109, drawn to an isolated nucleic acid that encodes a plant retroviral polypurine tract and further comprising at least a portion of a plant reverse transcriptase sequence, and further encoding at least one agronomically-significant characteristic; a vector that can transfer said nucleic acid to a plant cell; a seed or plant comprising said nucleic acid; a method to impart agronomically significant characteristics to a plant, classified in class 435, subclass 69.1, for example.
- X. Claims 79-85, 102-107, 109, drawn to an isolated nucleic acid that encodes a plant retroviral polypurine tract and further comprising at least a portion of a plant RNaseH sequence, and further encoding at least one agronomically-significant

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characteristic; a vector that can transfer said nucleic acid to a plant cell; a seed or plant comprising said nucleic acid; a method to impart agronomically significant characteristics to a plant, classified in class 800, subclass 285, for example.

Claims 49-56, 60, 77-85, 107, and 109 will be examined to the extent that they read on the elected invention.

The inventions are distinct, each from the other because of the following reasons:

Inventions I-X are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions different functions and effects. The nucleic acids comprising a plant retroviral primer binding site of Groups I-V do not require the nucleic acids comprising a plant retroviral polypurine tract of Groups VI-X. The nucleic acid comprising SEQ ID NO: 4 of Group I is not required by Groups II-V and VII-X. The nucleic acid encoding a plant envelope sequence of Group II is not required by Groups I, III-VI, and VIII-X. The nucleic acid encoding a plant integrase sequence of Group III is not required by Groups I-III, IV-VII, IX, and X. The nucleic acid encoding a plant reverse transcriptase sequence of Group IV is not required by Groups I-III, V-VIII, and X. The nucleic acid encoding a plant RNaseH sequence of Group V is not required by Groups I-IV and VI-IX.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Groups II-X, restriction for examination purposes as indicated is proper.

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Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication from the examiner should be directed to Ashwin Mehta, whose telephone number is 703-306-4540. The examiner can normally be reached on Mondays-Thursdays and alternated Fridays from 8:00 A.M to 5:30 P.M. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson, can be reached at 703-306-3218. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3014 and 703-872-9306 for regular communications and 703-872-9307 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

  
**ASHWIN D. MEHTA, PH.D.**  
**PATENT EXAMINER**

March 21, 2003